

REMARKS

Overview of the Office Action

Claims 1, 2, 14, 15, 21, 22 and 23 have been provisionally rejected on nonstatutory double patenting over claims 1 and 2 of copending patent application no. 10/080,949.

Claims 1-9, 12, 14-19, 21, 22, and 23 have been rejected under 35 USC §103(a) as unpatentable over U.S. Patent No. 5,287,181 (Holman) (USP 5,287,181) in view of U.S. Patent Appl. Pub. No. 2003/0110078 (Chang).

Claims 10, 11, and 20 have been rejected under 35 USC §103(a) as unpatentable over Holman in view of Chang, and further in view of U.S. Patent Appl. Pub. No. 2003/0014748 (Ben-David).

Status of the claims

Claims 1, 14, 21, 22, and 23 have been amended.

Claim 1-23 remain pending

Rejection of claims 1, 2, 14, 15, 21, 22, and 23 under the doctrine of obviousness-type double patenting

The Office Action states that claims 1, 2, 14, 15, 21, 22, and 23 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending patent application no. 10/080,949.

Since the claims have been provisionally rejected, Applicants elect to wait until the other rejections have been resolved to determine whether a terminal disclaimer will be necessary.

Summary of subject matter disclosed in the specification

The following descriptive details are based on the specification. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations, which are unclaimed.

Disclosed is an interactive method for generating a supplementary, program-related output. The disclosed method includes obtaining a programming signal, obtaining a supplementary, program-related data signal, combining the programming signal and the supplementary, program-related data signal into a broadcast signal, broadcasting the broadcast signal from a program signal source; receiving the broadcast signal, performing the programming signal of the received broadcast signal with reproduction equipment for an audience, generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal, storing the supplementary, program-related data signal of the received broadcast signal on a portable storage media, enabling retrieval of rewards data corresponding to products or services by accessing the stored supplementary, program-related data signal from the portable storage media, and selecting a reward from the retrieved rewards data.

Descriptive summary of Holman

Holman discloses an electronic redeemable coupon generating system. The system of Holman includes an encoder for encoding coupon-related data in a television signal transmission, a decoder for receiving the television signal transmission and extracting the coupon-related data therefrom, and a recording device for recording the extracted coupon-related data on a recording

medium for subsequent readout and redemption. The decoder of Holman includes a display driver for displaying indicia on a television monitor screen responsive to coupon-related data encoded in the television signal transmission. Upon observing the indicia on the television monitor screen, the user of the system of Holman can manually and selectively extract the coupon-related data from the television signal transmission. After an optional editing function, the extracted coupon-related data of Holman is stored on a recording medium such as a magnetically striped card. The decoder of Holman may be part of the standard circuitry of a closed-caption adapted or modified television set (see Abstract of Holman).

Descriptive summary of Chang

Chang discloses a system and method for broadcast advertising. The system of Chang includes a broadcast receiver that receives a broadcast signal. In addition to the usual video and/or audio data, the broadcast signal of Chang includes embedded product or service data. The broadcast receiver of Chang includes a memory slot that is sized and shaped to receive a portable memory media. In response to a signal received at the broadcast receiver, e.g., from a remote control unit, the embedded product data of Chang is extracted from the broadcast signal and downloaded to the portable memory media forming a virtual shopping list. To facilitate shopping, the portable memory media of Chang can then be installed in a shopping computer, e.g., in an information kiosk at a shopping mall to determine where a particular product can be found, how much it costs, etc. (see Abstract of Chang).

Rejection of claims 1-9, 12, 14-19, 21, 22, and 23 under 35 USC §103(a)

The Office Action states that the combination of Holman and Chang teaches all of Applicants' recited elements.

Independent claim 1 has been amended to recite an interactive method for generating a supplementary, program-related output, that includes "generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal", which Holman and Chang, whether taken alone or in combination, fail to teach or suggest. Support for the claim amendment can be found in paragraph [0030] of the published version of the present specification (US 2004/0230993).

According to Holman, "During the presentation of a television commercial, a logo or emblem 40 is seen in the upper right hand corner of the TV screen 38. If the viewer is interested in the product that is the subject of the commercial, the user pushes the VIEW button 9, and a message (a portion of the data from the data string) 8 is instantly decoded from the television signal transmission and displayed along the bottom of screen 38. As will be explained later, the data string comprising the message information signal is made up of many parts, one part of which is the message itself, which is displayed on the screen. The balance of the data string is temporarily ignored by the system until and unless the user requests that the electronic coupon be retained, and in such a case the entire data string will be stored in a memory inside of the electronic coupon home unit 1. The message can inform the viewer that the manufacturer or sponsor of the commercial has available an electronic coupon to be redeemed. For example, the message 8 might read "S1 discount on 6-pack of Coke". If the user wishes to take advantage of this offer, the COUPON button 11 is pressed, and coupon-related data is entered into an internal memory of the home unit 1. A confirmation signal is generated upon successful memorization of

a selected electronic coupon, which alters an attribute of the logo as a visual indicator of the confirmation. For example, a color in the logo will change upon confirmation. The viewer continues to push the VIEW button 9 each time a logo or emblem 40 is observed and the viewer is interested in the commercial product. Likewise, each time the viewer is interested in redeeming the coupon offer made in the message 8, the COUPON button 11 is pressed to store all selected coupon-related data for each commercial in the internal memory of home unit 1.” (see col. 6, lines 5-38 of Holman).

In other words, Holman discloses displaying a visual alert when an offer is available. Using the system of Holman, the user must be actually looking at the television screen to be made aware that an offer is currently available.

In contrast to Holman, Applicants’ recited invention provides an audible signal to alert the user that an offer is available. Thus, a user of Applicants’ recited invention would not miss an available offer if the user’s view, for some reason, temporarily distracted from the television screen. Thus, Holman fails to teach or suggest Applicants’ recited invention.

Chang also fails to teach anything about generating an audible (or visual) signal in response to the received broadcast signal including the supplementary, program-related data signal, as recited in Applicants’ claim 1.

Therefore, Holman and Chang whether taken alone or in combination, fail to teach or suggest, an interactive method for generating a supplementary, program-related output, that includes “generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal”, as recited in Applicants’ amended claim 1.

Independent claims 14 and 21-23 have each been amended to recite limitations similar to independent claim 1 and are, therefore, deemed to be patentably distinct over Holman and Chang for at least those reasons discussed above with respect to independent claim 1.

In view of the foregoing, Applicants submit that Holman and Chang, whether taken alone or in combination, fail to teach or suggest the subject matter recited in independent claims 1, 14, and 21-23. Accordingly, claim 1, 14, and 21-23 is patentable over Holman and Chang under 35 U.S.C. §103(a).

Dependent claims

Claims 2-9, 12, and 15-19, which depend from independent claims 1 and 14, incorporate all of the limitations of the respective independent claims and are, therefore, deemed to be patentably distinct over Holman and Chang for at least those reasons discussed above with respect to independent claims 1 and 14.

Rejection of claims 10, 11, and 20 under 35 USC §103(a)

The Office Action states that the combination of Holman, Chang, and Ben-David teaches all of Applicants' recited elements.

Holman and Chang have been previously discussed and fail to teach or suggest the invention recited in Applicant's independent claims 1 and 14.

Because Holman and Chang fails to teach or suggest the subject matter recited in independent claims 1 and 14, and because Ben-David does not teach or suggest the recited subject matter of independent claims 1 and 14 that Holman and Chang are missing, the addition

of Ben-David to the reference combination does not remedy the deficiencies of Holman and Chang.

Claims 10, 11, and 20, which depend from independent claims 1 and 14, incorporate all of the limitations of the respective independent claims and are, therefore, deemed to be patentably distinct over Holman, Chang, and Ben-David for at least those reasons discussed above with respect to independent claims 1 and 14.

Conclusion

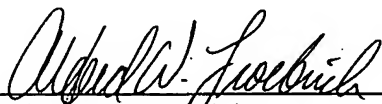
Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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Dated: September 29, 2008